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TECHNOLOGY CENTER R3700

REISSUE
LITIGATION

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE: Continuation of Continuation of
Reissue Application, U.S. Serial No.
08/880,748, Filed: 6-23-97,
a Continuation of Reissue Application,
U.S. Serial No. 08/369,910, Filed: 1-9-95
of Dillis V. Allen

INVENTOR: Dillis V. Allen

PATENT NO: 5,301,941

ISSUED: April 12, 1994

REISSUE NO: Re.36,950

REISSUED: 11-7-00

FOR: IMPROVED GOLF CLUB HEAD WITH INCREASED
RADIUS OF GYRATION AND FACE REINFORCEMENT

REISSUE CONTINUATION
SERIAL NO: 09/378,131
FILED: ~~8-20-99~~
EXAMINER: S. Passaniti
ART UNIT: 3711

U.S. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

RESPONSE TO OFFICE ACTION

Honorable Sir:

In response to the Office Action dated September
12, 2002, in the above application, the Patent Owner
responds to the numbered paragraphs as follows:

Paragraph 1 states:

"The maintenance fee has not been paid.
Therefore, the Preliminary Amendment filed
01/24/2000, has not been entered. No action
on the merits of this reissue application
will be rendered while the application is
based upon a lapsed patent."

This statement is in error. The '941 patent lapsed under law because of the issuance of the first reissue, Re. 36,950, on November 7, 2000. The 8th year maintenance fee in the reissue was timely paid, and a copy of the paid Maintenance Fee Statement is attached hereto as Exhibit A. Therefore, objection no. 1 should be withdrawn.

In Paragraph 2, the Examiner states:

"Claims 1-4 are rejected under 35 U.S.C. 251 as lacking basis for reissue, because by statute a reissue application can only be granted for the unexpired portion of the term of the original patent. See *In re Morgan*, 990 F.2d 1230, 26 USPQ2d 1392 (Fed.Cir.1983), which holds that reissue applications can only be issued for unexpired patents."

Since the maintenance fee in Re. 36,950 was timely paid as evidenced by Exhibit A, this rejection is no longer believed appropriate.

In Paragraph 3, the Examiner states:

"There would not appear to be a statement under 37 CFR 3.73(b) of record in the file. An assignee must establish its ownership interest in order to support the consent to a reissue application required by 37 CFR 1.172(a). An appropriate paper satisfying the requirements of 37 CFR 3.73 must be submitted in reply to this Office action."

This statement is also believed in error. The Assignee's Statement under 37 CFR 3.73 was filed by hand on January 14, 2000, and a copy of the hand-filed stamped postcard is attached hereto as Exhibit B.

Paragraph 4 states:

"Page 1 of the specification appears to be missing from the application papers."

This is also believed in error but page 1 of the specification is attached hereto as Exhibit C.

Paragraph 5 states:

The patent sought to be reissued by this application is involved in litigation. Any documents and/or materials which would be material to the patentability of this reissue application are required to be made of record in reply to this action. Due to the related litigation status of this application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED DURING THE PROSECUTION OF THIS APPLICATION."

Firstly, the Examiner's attention is directed to the Notice of Pending Litigation under MPEP 1442.04, filed on August 30, 2000, in which many items of prior art are cited. Furthermore, the Patent Owner is filing herewith copies of the Complaints in *Vardon Golf Company Inc. vs. Karsten Manufacturing Corporation*, Case No. 99 C 2785, Exhibit D; *Vardon Golf Company Inc. vs. Karsten Manufacturing Corporation*, Case No. 00 C 7221, Exhibit E; and *Vardon Golf Company vs. Golfsmith International, Inc., et al.*, Case No. 98 C 2944, Exhibit F, all filed in the United States District Court for the Northern District of Illinois, Eastern Division. Also, a document entitled "941 Patent Prior Art References" involved in Case No. 99 C 2785, is attached hereto as Exhibit G, and a document entitled "Golfsmith In-

ternational Inc.'s Notice Under 35 U.S.C. 282" filed on April 10, 2000, in Case No. 98 C 2944, is attached hereto as Exhibit H.

The Patent Owner is also calling the Examiner's attention to the following patents which were cited in the original U.S. Patent No. 5,301,941, and the first continuation reissue, Patent No. Re.36,950:

U.S. PATENTS

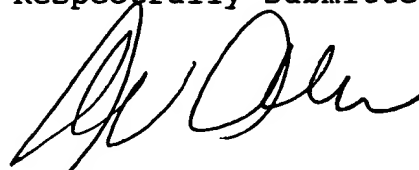
D. 229,431	11/1973	Baker	3,640,534	2/1972	Mills
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922,444	5/1909	Youds	3,873,094	3/1975	Sebo
1,459,810	5/1923	Wills	3,947,041	3/1976	Barber
1,568,888	1/1926	Dunn	4,076,254	2/1978	Nygren
1,587,758	6/1926	Caaravay	4,679,792	7/1987	Straza
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1,683,639	9/1928	Vaile	4,730,830	3/1988	Tilley
2,083,189	6/1937	Crooker	4,930,781	6/1990	Allen
2,429,351	10/1947	Fetterolf	5,042,806	8/1991	Helmstetter
3,077,350	2/1963	Koorland	5,060,951	10/1991	Allen

FOREIGN PATENTS

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0049130	4/1977	Japan
10187	of 1893	United Kingdom
6385	of 1893	United Kingdom
8954	of 1893	United Kingdom
9514	of 1898	United Kingdom
15 597	of 1904	United Kingdom
876414	8/1961	United Kingdom
2109249	6/1983	United Kingdom

For the above reasons, it is now requested that
this application be examined on its merits.

Respectfully submitted,



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Attorney for Assignee

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I hereby certify that this correspondence,
Response....., is being deposited
with the United States Postal Service
as First Class mail in an envelope
addressed to: Commissioner of
Patents and Trademarks, Washington,
D. C. 20231, on *October 10, 2002*..... 198...



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Attorney,

October 10, 2002
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Date